

REMARKS:

In the outstanding Office Action, the Examiner rejected claims 1-5, 10 and 11. Claims 1, 2, 3, 5, 10 and 11 are amended herein, and new claim 12 is added. No new matter is presented. Claims 6-9 remain cancelled. Thus, claims 1-5 and 10-12 are pending and under consideration. The rejections are traversed below.

REJECTION UNDER 35 U.S.C. § 112 ¶2:

Claims 1-5, 10 and 11 were rejected under 35 U.S.C. § 112 ¶2. Claims 1, 2, 3, 5, 10 and 11 are amended herein. Proper support for the amendment can be found at least on page 6 line 21 to page 7 line 19, page 17 line 21 to page 18 line 5 including operation SA16.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §103(a):

Claims 1-5, 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. 2001/0037283 (Mullaney) and the article "Word of mouth takes off" (Word).

In the outstanding Office Action, the Examiner indicated that Official Notice has been taken regarding copying of information of existing customer to a second file and that input of an e-mail address from an address book is well known. The Applicants respectfully traverse the Examiner's statement and demand the Examiner to produce authority for the statement. The Applicants specifically point out the following errors in the Examiner's action.

First, the Examiner uses common knowledge ("well-known") evidence for the rejection. As explained in the M.P.E.P.,

any facts so noticed should... server only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based.

M.P.E.P. § 2144.03

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the

present invention (see, M.P.E.P. § 2144.03(A) (the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the Examiner's assertion (see, M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, the Examiner appears to be basing the rejections, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such assertion with an affidavit when called for by the Applicant. The Examiner is called upon to support such assertion.

Further, even if the Examiner's assertion and rejection based on common knowledge and Official Notice is valid, the present invention is distinguishable as discussed below.

Mullaney is directed to business referral schemes based on cross-referral agreements between members of a marketing community (see, paragraphs 29, 33 and 40). For example, marketing community member A with clients associated therewith and marketing community member B having corresponding associated clients may enter into e-mail cross-referral agreements such that information about one of the members is included in e-mail messages sent on behalf of one member to clients of the other member (See, paragraph 33). That is, Mullaney is limited to joint agreements where an e-mail is sent to all clients of agreeing marketing communities.

The Examiner asserts that Mullaney discloses sending a plurality of mails to a plurality of different second terminals because spaces for three referrals are disclosed in Fig.4 of Mullaney. However, as disclosed in paragraph 44, Fig. 4 of Mullaney illustrates a page on a website where one has to input e-mail addresses in the spaces for three referrals.

The Examiner also asserts that Word shows sending the second e-mail to be transferred to a second terminal to the first terminal and the existing customer forwarding the second e-mail to the second terminal. However, Word relates to a marketing method using word of mouth communication for passing information by verbal means according to which consumers who act as trusted sources of information by sharing targeted promotions with their friends and family are rewarded. Word states that "... more than 30 percent of people who receive a referral mail from a friend are clicking through to search for a car at iMotors " (page 2) and "Takira.com handles all aspects of each referral campaign, from creative development and e-mail delivery, to tracking and

reporting, reward fulfillment and customer service" (page 3). However, Word fails to disclose that the existing customer transfers the second e-mail to the second terminal of the potential new customer as discussed below.

Independent claim 1 recites, "transmitting to an existing customer a first e-mail requesting an introduction of a new customer-to-be", "registering the information on the existing customer to a second file when receiving an application from the existing customer" and "transmitting a second e-mail to be transferred to a second terminal of the new customer, including information on the business" (emphasis added). Claim 1 further recites, "registering information of the new customer to a third file when the new customer places an order through the Web site", where "the information of the existing customer in the second file is checked with the information on the new customer in the third file when the order is received from the second terminal." Independent claim 5 recites similar features.

Similarly, independent claim 10 recites, "transmitting a first e-mail requesting an introduction of a new customer to a terminal of an existing customer based on information on the existing customer in a first file" and "registering the information of the existing customer to a second file based on a response to the first e-mail from the existing customer." Information related to the business contained in "a second e-mail" is transmitted "via the terminal of the existing customer", where "information of the existing customer is checked with the information on the new customer in the third file when the orders are received from the other terminals."

Independent claim 11 recites, "receiving information of a potential customer from an existing customer in response to a first e-mail sent to the existing customer" and "sending a second e-mail using a terminal of the existing customer", where information of the potential customer and the existing customer are "categorically stored based on receipt of a response to the first e-mail or the second e-mail."

Mullaney and Word do not teach or suggest "a first e-mail" transmitted to an existing customer and "a second e-mail to be transferred to a second terminal" that is transmitted to "the terminal of the existing customer", as recited in each of the independent claims ("sending a second e-mail using a terminal of the existing customer" in claim 11).

It is submitted that the independent claims are patentable over Mullaney and Word.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over the cited references. The dependent claims are also independently patentable. For example, as recited in claim 3, "the second e-mail is transferred

to an e-mail address selected from an e-mail address book of the first terminal." Mullaney and Word, alone or in combination, do not teach or suggest these features of claim 3.

Therefore, withdrawal of the rejection is respectfully requested.

NEW CLAIM:

New claim 12 has been added to recite, "requesting data of a potential customer from an existing customer using a first e-mail and sending a second e-mail responsive to receipt of requested data from the existing customer." Claim 12 further recites, "forwarding the received second e-mail to the potential customer and selectively storing data of the existing customer in corresponding files in accordance with receipt of the first e-mail, the second e-mail or an order from the potential customer."

Mullaney and Word, alone or in combination, do not teach or suggest, the above-discussed features of claim 12 including "forwarding the received second e-mail to the potential customer and selectively storing data of the existing customer in corresponding files in accordance with receipt of the first e-mail, the second e-mail or an order from the potential customer", as recited in claim 12.

It is submitted that new claim 12 is patentably distinguishable over Mullaney and Word.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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